

**REMARKS**

Claims 1-16 and 18-20 are pending in this application. By this Amendment, claims 15, 19 and 20 are amended, and claim 17 is canceled.

Support for the amendments to claim 15 can be found in claim 17 as originally filed. No new matter is added by this Amendment.

Applicants appreciate the courtesies shown to Applicants' representative by Examiner Rogers in the June 5, 2007 interview. Applicants' separate record of the substance of the interview is incorporated into the following remarks.

**I. Information Disclosure Statement**

Applicants filed an Information Disclosure Statement (IDS) for the present application on August 25, 2004. However, the IDS has not been acknowledged and the reference cited therein has not been considered by the Patent Office. Receipt of the IDS is also not listed in the transaction history available on the PAIR system. Thus, attached is a copy of the IDS as filed on August 25, 2004, along with a date-stamped filing receipt confirming that the IDS, Form 1449, and one reference were submitted to the Patent Office on that date.

Applicants request that the IDS be acknowledged and the reference be considered by the Patent Office.

**II. Rejections under 35 U.S.C. §102(e)**

Claims 1-16 and 18-20 were rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent Application Publication No. 2003/0044370 to Sasaki et al. (hereinafter "Sasaki et al. '370"); and claims 1-16 and 18 were rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent No. 6,893,649 to Sasaki et al. (hereinafter "Sasaki et al. '649"). The rejections are respectfully traversed.

The Patent Office alleges that Sasaki et al. '370 and/or Sasaki et al. '649 disclose all of the features recited in claims 1-16 and 18-20. Applicants respectfully disagree.

Nowhere does Sasaki et al. '370 and/or Sasaki et al. '649 disclose a resin powder having particles that when seen from a direction in which a projected area of the particle to a plane is maximum, the particles satisfy the following equations:  $0.5 < b/a < 1$ , and  $0.4 < c/b < 0.8$  where  $a$  is a major axis of each particle,  $b$  is a minor axis of each particle, and  $c$  is a thickness of each particle as required in claims 1-16 and 18-20.

The Patent Office alleges that it is inherent that Sasaki et al. '370 and/or Sasaki et al. '649 teach the same dimensions as those claimed. However, the first Declaration under 37 CFR §1.132, filed on December 15, 2006, clearly established that required dimensions of the particles in claims 1, 15 and 18-20 are not inherent to particles formed in accordance with the teachings of Sasaki et al. '370 and Sasaki et al. '649.

The Patent Office dismissed this evidence as allegedly irrelevant to an anticipation rejection. However, the first Declaration is quite proper in rebutting the Patent Office's allegation of inherency. The first Declaration provides evidence that the particles formed in accordance with Sasaki et al. '370 and Sasaki et al. '649 do not exhibit the claimed dimensions as the particles recited in claims 1, 15 and 18-20. More specifically, the first Declaration illustrates that particles formed in accordance with the teachings of Sasaki et al. '370 (comparative resin powder A of the first Declaration) and Sasaki et al. '649 (comparative resin powder B of the first Declaration) fail to satisfy the projected particle dimension limitations, namely  $0.5 < b/a < 1$  and  $0.4 < c/b < 0.8$ , as required in claims 1, 15 and 18-20. As set forth in Table 1 of the first Declaration, particles of resin powders formed in accordance with the teachings of Sasaki et al. '370 and/or Sasaki et al. '649 exhibit  $b/a = 1$  and  $c/b = 1$ , which clearly fail to satisfy the recited equations,  $0.5 < b/a < 1$  and  $0.4 < c/b < 0.8$ , as specifically defined in claims 1, 15 and 18-20.

The Patent Office also asserted that the evidence presented in the first Declaration is allegedly insufficient in only showing one working example of Sasaki '370 with particles

having a SF1 of 112 and one working example of Sasaki '649 with particles having a SF1 of 115. Applicants submit that this evidence is sufficient. As discussed above, neither reference teaches a reshaping of the particles. Thus, it is quite clear that all processes in the references would achieve spherical particles ( $b/a$  and  $c/b$  of 1), as confirmed by the evidence already submitted. Without reshaping, different  $b/a$  and  $c/b$  values, would not be expected. The evidence is thus representative of the teachings in the references. Moreover, Applicants submit that the burden is on the Patent Office to establish evidence as to why the evidence is not sufficient, i.e., why different results might be expected, and the Patent Office cannot meet this burden because reshaping particles is not disclosed in either Sasaki '370 or Sasaki '649.

Moreover, attached is a second Declaration under 37 CFR §1.132 illustrating that particles formed in accordance with the teachings of Sasaki et al. '370 (see first comparative examples 1-7 of second Declaration) and Sasaki et al. '649 (see second comparative examples 1-8 of second Declaration) fail to satisfy the projected particle dimension limitations, namely  $0.5 < b/a < 1$  and  $0.4 < c/b < 0.8$ , as required in claims 1 and 18-20. As set forth in Table 1 of the second Declaration, particles of resin powders according to the teachings of Sasaki et al. '370 exhibit  $b/a$  values of 0.9 (see first comparative example 2 in Table 1) or 1 (see first comparative examples 1 and 3-7 in Table 1) and  $c/b = 1$  (see comparative examples 1-7 in Table 1), which clearly fail to satisfy the equations of the present claims,  $0.5 < b/a < 1$  and  $0.4 < c/b < 0.8$ . Additionally, Table 1 confirms that even though comparative examples 1-7 in Table 1 may have a shape factor SF1 value within a range of 110 to 140, the particles of comparative examples 1-7 still fail to satisfy the equations of claims 1 and 18-20.

Additionally, as set forth in Table 2 of the second Declaration, particles of resin powders according to the teachings of Sasaki et al. '649 exhibit  $b/a$  values of 0.8 (see second comparative examples 6 and 8 in Table 2), 0.9 (see second comparative example 5 in Table 2) or 1 (see second comparative examples 1-4 and 7 in Table 2) and  $c/b = 0.9$  (see second

comparative examples 3, 6 and 7 in Table 2), 1 (see second comparative examples 1, 2, 4 and 8 in Table 2) or 1.1 (see second comparative example 5), which clearly fail to satisfy the equations of the present claims,  $0.5 < b/a < 1$  and  $0.4 < c/b < 0.8$ . Additionally, Table 2 sets forth that even though second comparative examples 1-4 and 7 in Table 2 may have a shape factor SF1 value within a range of 110 to 140, the particles of second comparative examples 1-4 and 7 fail to satisfy the equations of claims 1 and 18-20.

The evidence in the first and second Declarations confirms that the particles of Sasaki et al. '370 and/or Sasaki et al. '649 are spherical and do not satisfy the required equations in claims 1, 15 and 18-20. The particles of Sasaki et al. '370 and/or Sasaki et al. '649 fail to satisfy the required equations in claims 1, 15 and 18-20 because the particles are not reshaped to have dimensions that satisfy those required equations. In other words, producing particles in accordance with the teachings of Sasaki et al. '370 and/or Sasaki et al. '649 achieves spherical particles only because no reshaping is effected that achieves dimensions that satisfy the equations recited in claims 1, 15 and 18-20 (see comparative resin powders A and B of first Declaration, and first comparative examples 1-7 and second comparative examples 1-8 of the second Declaration).

The Patent Office also alleges that Sasaki '370 and Sasaki '649 disclose particles with an SF1 of between 110 and 140 as in the present application, and thus would allegedly have the recited dimensions. Applicants submit that simply because the Sasaki '370 and Sasaki '649 particles may have a SF1 value between 110 and 140 fails to teach or suggest that those particles have particle dimensions that satisfy the recited equations in claims 1, 15 and 18-20 (see first comparative examples 1-7 and second comparative examples 1-4 and 7 of the second Declaration). SF1 and the dimensions  $b/a$  and  $c/b$  are not dependent on each other. In fact, the first and second Declarations confirm that the particles of Sasaki '370 and Sasaki

'649 that have SF1 values within the recited range, have b/a values and c/b values outside the requirements recited in claims 1, 15 and 18-20.

The burden is on the Patent Office to provide evidence that all of the features of claims 1, 15 and 18-20 are necessarily anticipated by Sasaki et al. '370 and/or Sasaki et al. '649. In view of the above, and the evidence illustrated in the first Declaration, Applicants submit that claims 1, 15 and 18-20 are not anticipated by Sasaki et al. '370 and/or Sasaki et al. '649.

In view of the foregoing, Sasaki et al. '370 and/or Sasaki et al. '649 fail to disclose each and every limitation of independent claims 1-16 and 18-20. Accordingly, reconsideration and withdrawal of these rejections are respectfully requested.

### **III. Rejections under 35 U.S.C. §103(a)**

#### **A. Sasaki et al. '370 in view of Sakuma**

Claims 1-20 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Sasaki et al. '370 in view of U.S. Patent Publication No. US 2003/0023021 A1 to Sakuma. This rejection is respectfully traversed.

Claim 15 was amended to incorporate the features of claim 17 as suggested by Examiner Rogers during June 5 interview.

Neither Sasaki et al. '370 nor Sakuma, taken singly or in combination, teaches or suggests a resin powder having particles that when seen from a direction in which a projected area of the particle to a plane is maximum, the particles satisfy the following equations:  $0.5 < b/a < 1$  and  $0.4 < c/b < 0.8$  where a is a major axis of each particle, b is a minor axis of each particle, and c is a thickness of each particle as recited in claims 1 and 18-20.

Neither Sasaki et al. '370 nor Sakuma, taken singly or in combination, teaches or suggests a process for preparing a resin powder for cosmetic including particles containing a resin, comprising a step of flattening the particles by colliding the particles against a uniform

plane under high pressure, wherein the particles have a degree of hydrophobicity of from 10 % to 60 %, and when seen from a direction in which a projected area of the particle to a plane is maximum, the particles are satisfactory with the following equations:  $0.5 < b/a < 1$  and  $0.4 < c/b < 0.8$  where  $a$  is a major axis of each particle;  $b$  is a minor axis of each particle; and  $c$  is a thickness of each particle as required in claim 15.

The Patent Office admits that Sasaki et al. '370 fails to disclose reshaping the particles by a treatment, and alleges Sakuma does such a reshaping.

However, Sakuma does not remedy the deficiencies of Sasaki et al. '370 as described above with respect to claims 1, 15 and 18-20.

Applicants submit that particle dimensions that satisfy the equations as required in claims 1, 15 and 18-20 are not inherent to the particles of Sasaki et al. '370 as alleged by the Patent Office for the reasons described above with respect to the rejection under 35 U.S.C. §102(e). Additionally, Applicants submit that Sakuma fails to teach or suggest particles that satisfy the following equations:  $0.5 < b/a < 1$  and  $0.4 < c/b < 0.8$ , where  $a$  is a major axis of each particle;  $b$  is a minor axis of each particle; and  $c$  is a thickness of each particle as specifically defined in claims 1, 15 and 18-20.

In fact, although Sakuma does describe a shaping of particles, Sakuma teaches away from particles as defined in the present application. For example, it is described in the present application that particles with the recited dimensions have a shape that "is not a so-called cigar shape or an acicular or tabular form, but a disk-like shape or an elliptical shape keeping a sphere to some extent, such as a rugby ball shape" (see page 12, line 24 to page 13, line 2). To the contrary, Sakuma teaches that "since each of the resin particles of this invention has a boundary line, the number of particles per unit weight is large in comparison with non-spherical resin particles having no boundary line, for example, hemispherical, rugby ball shaped, wooden-bowl shaped and go stone shaped particles which have been reported"

(see paragraph [0117] in Sakuma). Sakuma thus requires particles with a distinct boundary line, and specifically indicates that the particles therein are shaped differently than the particles disclosed in the present application having a rugby ball shape. Sakuma specifically teaches away from rugby ball shape particles, indicating that such particles lack a sufficient number of particles per unit weight, and thus teaches away from the recited dimensions in the present claims.

Therefore, Applicant asserts that even if Sasaki et al. '370 were to have been combined with Sakuma as alleged by the Patent Office, the deficiencies of Sasaki et al. '370 as described above with respect to claims 1, 15 and 18-20 would not have been remedied. That is, the shape of the particles of Sakuma not only fails to teach or suggest particle dimensions that satisfy the recited equations, but also teaches away from particle dimensions that satisfy the recited equations as required in claims 1, 15, and 18-20. Thus, the combination of Sasaki et al. '370 and Sakuma does not achieve the present resin powder having particles with dimensions that satisfy the equations specifically defined in claims 1, 15 and 18-20.

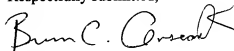
Since neither Sasaki et al. '370 nor Sakuma, taken singly or in combination, teaches or suggests each and every feature as claimed, the claims are patentably distinct over the references. Accordingly, reconsideration and withdrawal of the rejection of the claims under 35 U.S.C. §103(a) are respectfully requested.

#### **IV. Conclusion**

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-16 and 18-20 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Brian C. Anscomb  
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JAO:BCA/hs

Attachments:

Copy of August 25, 2004 Information Disclosure Statement  
Date-stamped Receipt dated August 25, 2004  
Declaration Under Rule 37 CFR §1.132

Date: July 5, 2007

**OLIFF & BERRIDGE, PLC**  
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**Alexandria, Virginia 22320**  
**Telephone: (703) 836-6400**

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IDS, PTO 1449 W/ 1 REF (1 ABSTR & 1 TRANSL)

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**Name of Applicant:** Yuki SASAKI et al.

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**Serial No.:** 10/731,031

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**Atty. File No.:** 118048

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**Title (New Cases):**

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**Sender's Initials:** JAO/mps

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59/2A

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Yuki SASAKI et al.

Group Art Unit: 1714

Application No.: 10/731,031

Filed: December 10, 2003

Docket No.: 118048

For: RESIN POWDER FOR COSMETIC AND COSMETIC USING THE SAME

INFORMATION DISCLOSURE STATEMENT

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Pursuant to 37 CFR §1.56, the attention of the Patent and Trademark Office is hereby directed to the reference listed on the attached PTO-1449. Unless otherwise indicated herein, one copy of each reference is attached. It is respectfully requested that the information be expressly considered during the prosecution of this application, and that the reference(s) be made of record therein and appear among the "References Cited" on any patent to issue therefrom.

- ☒ 1. This Information Disclosure Statement is being filed (a) within three months of the U.S. filing date of this non-CPA application, OR (b) before the mailing date of a first Office Action on the merits in the present application. No certification or fee is required.
- ☒ 2. An English-language Abstract of the non-English language reference 1 is attached hereto.
- ☒ 3. A computer-generated English translation of the following Japanese reference has been obtained from the website of the Japanese Patent Office ([<http://www.jpo.go.jp>]), and is attached, but has not been reviewed for accuracy. See Reference 1.

Respectfully submitted,

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INFORMATION DISCLOSURE STATEMENT  (Use several sheets if necessary)				APPLICANTS Yuki SASAKI et al.			
				FILING DATE December 10, 2003		GROUP	

U.S. PATENT DOCUMENTS						
EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS

FOREIGN PATENT DOCUMENTS						
		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB CLASS
	1	JP A 10-338616	12/22/98	JAPAN		

OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, etc.)						

EXAMINER	DATE CONSIDERED
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Examiner:	Initial if citation considered, whether or not citation is in conformance with M.P.E.P. 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.
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